This document is in response to the Request for Comments published in the Federal Register, Vol. 68, No. 249 on December 30, 2003, regarding the equities of Inter Partes Reexamination Proceedings. With respect to the stated inquiries set forth in the Request for Comments:

(1) Although I have represented organizations that qualify as small entities, the following comments are not made with such organizations in mind.

(2) I have not been a participant in an inter partes reexamination proceeding.

(3)-(6) In accordance with the provisions of 35 U.S.C. 314(c), unless otherwise provided by the Director, all inter partes reexamination proceedings, including any appeal to the Board of Patent Appeals and Interferences are to be conducted with special dispatch. There are two procedural aspects of the current rules where substantial delays in proceeding can occur. First, while 35 U.S.C. 312 provides that the Director shall make a determination as to whether a request for inter partes reexamination raises a substantial new question of patentability within three months of filing the request, there are no other provisions regarding the period for handling of the documents filed by the parties and sending out official communications on the part of the United States Patent and Trademark Office. However, since the same statutory basis exists in ex parte reexamination and there generally has not been a problem with respect to the PTO's compliance with the "special dispatch" provisions of the statute, it may well develop that the PTO will likewise be able to comply with the "special dispatch" provisions of the statute relating to inter partes reexamination.

Assuming 1) that there are no extensions of time during the inter partes reexamination proceeding; 2) that Official Actions are mailed within about two months of the third party requester's comments; 3) that the proceeding goes directly to an Action closing prosecution and a right of appeal notice; and 4) that there is approximately 6 months from the filing of the last rebuttal brief through an oral hearing to the decision by the Board, the Board decision will be about two years after filing the initial request. If the Board decision is favorable to the patent owner, it is unlikely that the third party requester will accept the decision and will likely appeal the Board decision to the Court of Appeals to the Federal Circuit which will delay the final decision further along with the ultimate issuance of the Reexamination Certificate. In light of the recent statutory revisions to permit third party requester participation in the appeal to the Federal Circuit, the patent owner will have to accept that a typical inter partes reexamination proceeding will require on the order of three years to complete under the best of circumstances.

There is one aspect of the proceeding before the PTO which could further delay the ultimate resolution of the proceeding. That is, the third party requester can appeal the decision by the Examiner not to make one or more proposed rejections set forth in the request. If the Board decides to reverse the Examiner's decision not to make a proposed rejection and the patent owner decides to amend the claims and/or present evidence in support of patentability, the jurisdiction of the proceeding will be returned to the Examiner. This aspect of the procedure will entail an opportunity by the third party requester for comments, the Examiner's determination and further comments by the patent owner and third party requester before the proceeding is returned to the Board for its decision under 37 C.F.R. 1.977(f). This aspect of the proceeding could easily require 8-12 months of additional time before the second decision by the Board is rendered.

To reduce the possibility of a reversal by the Board of an Examiner's decision not to make one or more proposed rejections set forth in the request, it is proposed that a procedure be instituted to consider immediately all decisions not to make proposed rejections. Such a procedure can include a Patentability Review Conference before the initial Official Action is sent. Additionally, the PTO can require that the third party requester within 30 days of the initial Official Action file a petition under 37 C.F.R. 1.927 (which may have to be amended to explicitly provide for such a petition) explaining why the rejections not made by the Examiner should also be made. The PTO may require that the third party requester explain why the proposed rejections that are the subject

of the petition are more relevant or necessary in light of the rejections made by the Examiner in the initial Action. The petition can preferably be decided by the Patentability Review Conference within 30 days of the petition and without input from the patent owner who will have an opportunity to respond to any newly made rejection when the Official Action is reissued. During this time, the patent owner's time period for responding to the initial Action would be stayed. Any proposed rejections that are not included in the petition would not be eligible for appeal to the Board, but would be subject to the estoppel provisions of 35 U.S.C. 317 and 37 C.F.R. 1.907. In this way, it is anticipated that there will be a clear record setting forth the reasons why proposed rejections were not made and few instances where the Board will reverse the decision not to make a proposed rejection.

The foregoing comments are made solely as an individual and are not to be attributed to my firm.

Respectfully submitted,

Robert G. Mukai